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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,976	04/02/2004	Atsushi Fukui	900-495	7726
23117 7590 07/05/2007 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203				
			EXAMINER TRINH, THANH TRUC	
			ART UNIT 1753	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/815,976

Applicant(s)

FUKUI ET AL.

Examiner

Thanh-Truc Trinh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 10-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 4/2/2004.
- ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9, drawn to a product, classified in class 136, subclass 263
- II. Claims 10-20, drawn to a method, classified in class 438, subclass 57.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by different methods such as sputtering.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

During a telephone conversation with the Applicant's representative, H. Warren Burnam, Jr., on 5/14/07 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-9. Affirmation of this election must be made by applicant in replying to this Office Action. Invention of Group II is withdrawn from further

consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Lupo et al. (US Patent 5885368)

Regarding claims 1-4 and 7, as seen in Figure 1, Lupo et al. disclose a dye-sensitized solar cell comprising a transparent conductive layer (11), a porous semiconductor of titanium oxide (12) on which a dye sensitizer is adsorbed, a carrier transport layer (14) and an counter electrode (15) which are formed in this order on a transparent substrate (16). (See col. 2 lines 30-57). The dye sensitizer is made of metal complex dye such as cis-bis(isothiocyanato)bis(2,2'-bipyridyl-4,4'-dicarboxylate)-ruthenium(II) (See formula VIII). Lupo et al. also describe that the absorbance peak of the porous semiconductor layer after being rinsed with ethanol and dried in a warm air stream is 500 nm. (See col. 26 lines 58-67 bridging col. 27 lines 1-3, or col. 27 lines 40-52).

Regarding the limitation of "the absorbance peak of the porous semiconductor layer is located on a shorter wavelength side of the absorbance spectrum than that of

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the porous semiconductor layer observed immediately after the dye sensitizer is adsorbed", Applicant's disclosure states that this limitation is the result of thermal treatment. (Specification, Page 13). Lupo et al. describe the dye-sensitized semiconductor is subjected to a warm air stream, (See col. 26 lines 58-67 bridging col. 27 lines 1-3, or col. 27 lines 40-52), therefore the Examiner considers that the reference reads on the limitation.

3. Claims 1-4 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoshikawa (PGPub 20020040728)

Regarding claims 1-4 and 7, as seen in Figure 1, Yoshikawa discloses a dye-sensitized solar cell comprising a transparent conductive layer (10), a porous semiconductor of titanium oxide (20) on which a dye sensitizer (22) is adsorbed, a carrier transport layer (30) and an counter electrode (40) which are formed in this order on a transparent substrate (50). (See paragraphs [0069] and [0074]-[0111]). The dye sensitizer is made of metal complex dye such as cis-bis(isothiocyanato)bis(2,2'-bipyridyl-4,4'-dicarboxylato)-ruthenium (II). (See formula III and R-1 in paragraph [0111]).

Regarding the limitation of "the absorbance peak of the porous semiconductor layer is located on a shorter wavelength side of the absorbance spectrum than that of the porous semiconductor layer observed immediately after the dye sensitizer is adsorbed", Applicant's disclosure states that this limitation is the result of chemical treatment. (Specification, Pages 13-15). Yoshikawa describes that the dye-sensitized

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semiconductor is subjected to a chemical treatment with heteroatom-containing compounds such as tetrahydrofuran, imidazole, etc., to improve the efficiency, (See paragraphs [0027]-[0067]), therefore the Examiner considers that the reference reads on the limitation.

Since Yoshikawa discloses all the structural and material limitations of the instant claims, it is the Examiner's position that the absorbance peak of the porous semiconductor layer is inherently located within the range of 500 nm \pm 30 nm.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. Claims 5-6 and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lupo et al. (US Patent 5885368) in view of Andriessen et al. (WO 2004/025748).

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Regarding claims 5-6 and 8-9, Lupo et al. disclose a dye-sensitized solar cell as described in claim 1 or 2.

Lupo et al. do not explicitly disclose the dye sensitizer is made of cis-bis(isothiocyanato)bis(2,2'-bipyridyl-4,4'-dicarboxylato)-ruthenium(II)bis-tetrabutylammonium, tris(isothiocyanato)-ruthenium(II)-2,2':6',2''-terpyridine-4,3',4''-tricarboxylic acid, tris-tetrabutylammonium salt.

Andriessen et al. disclose the dye sensitizer is made of cis-bis(isothiocyanato)bis(2,2'-bipyridyl-4,4'-dicarboxylato)-ruthenium(II)bis-tetrabutylammonium, or tris(isothiocyanato)-ruthenium(II)-2,2':6',2''-terpyridine-4,3',4''-tricarboxylic acid. (See table on page 18).

Relevant to claims 6 and 9, in regards to formula (1), Applicant's disclosure states that the formula is of Ruthenium 620-1H3TBA commercialized by Solaronix, Swiss (Specification, Page 12 paragraph 2). Andriessen et al. teach using Ruthenium 620 as a dye sensitizer in solar cell (see table on page 18 of Andriessen et al.). Also, a MSDS of Ruthenium 620-1H3TBA from Solaronix is provided to support the fact that this compound has been commercialized before the time the invention was made. Thus, the Examiner considers the reference teaches the instant limitation.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Lupo et al. by specifically using the dye sensitizers as taught by Andriessen et al., because it would allow a broad absorption. (See page 17 of Andriessen et al.).

In such a combination, the absorbance peak of the porous semiconductor layer is inherently located within the range of $490\text{ nm} \pm 35\text{nm}$, or $580\text{ nm} \pm 35\text{ nm}$.

5. Claims 5-6 and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshikawa (PGPub 20020040728) in view of Andriessen et al. (WO 2004/025748).

Regarding claims 5-6 and 8-9, Yoshikawa discloses a dye-sensitized solar cell as described in claim 1 or 2.

Yoshikawa discloses the general formula of ruthenium dye sensitizer, but does not specifically list out cis-bis(isothiocyanato)bis(2,2'-bipyridyl-4,4'-dicarboxylato)-ruthenium(II)bis-tetrabutylammonium or tris(isothiocyanato)-ruthenium(II)-2,2':6',2''-terpyridine-4,3',4''-tricarboxylic acid, tris-tetrabutylammonium salt.

Andriessen et al. disclose the dye sensitizer is made of cis-bis(isothiocyanato)bis(2,2'-bipyridyl-4,4'-dicarboxylato)-ruthenium(II)bis-tetrabutylammonium and tris(isothiocyanato)-ruthenium(II)-2,2':6',2''-terpyridine-4,3',4''-tricarboxylic acid. (See table on page 18).

Relevant to claims 6 and 9, in regards to formula (1), Applicant's disclosure states that the formula is of Ruthenium 620-1H3TBA commercialized by Solaronix, Swiss (Specification, Page 12 paragraph 2). Andriessen et al. teach using Ruthenium 620 as a dye sensitizer in solar cell (see table on page 18 of Andriessen et al.). Also, a MSDS of Ruthenium 620-1H3TBA from Solaronix is provided to support the fact that this compound has been commercialized before the time the invention was made. Thus, the Examiner considers the reference teaches the instant limitation.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Yoshikawa by applying dye sensitizers as taught by Andriessen et al., because it would allow a broad absorption. (See page 17 of Andriessen et al.).

In such a combination, the absorbance peak of the porous semiconductor layer is inherently located within the range of $490\text{ nm} \pm 35\text{nm}$, or $580\text{ nm} \pm 35\text{ nm}$.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh-Truc Trinh whose telephone number is 571-272-6594. The examiner can normally be reached on 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on 571-272-1342. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TT
6/12/2007



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